

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

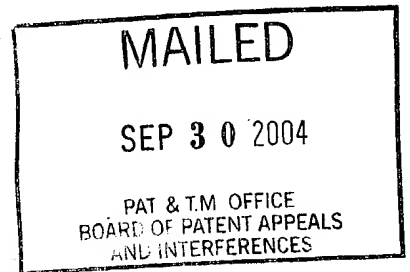
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS F. FORTE

Appeal No. 2004-2210
Application No. 09/374,117

ON BRIEF



Before GARRIS, WALTZ, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 26-29 and 32 which are all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to a breathable film having at least three layers. Claim 26 is illustrative:

26. A multilayer breathable film having the combination of properties of:

- (i) providing a barrier to microorganisms; and
- (ii) providing a barrier to blood and bodily fluids;

said breathable film comprising at least a three-layer film having as a minimum the following structure:

C:D:C;

where C comprises an outer monolithic layer containing a hydrophilic polymeric resin capable of absorbing and desorbing moisture and providing a barrier to water and microorganisms, said C layer being substantially free of particulate filler; and, D comprises a microporous adhesive core layer for bonding said C layers together, wherein said C layer substantially prevents the buildup of particulate filler material on a die during formation of said multilayer breathable film, and wherein said microporous adhesive core layer comprises particulate filler having an average particle size between about .8 microns and about 3 microns, where upon stretching the microporous adhesive the core layer [sic] has microvoids in a range from about 27.6% to about 42%, said microporous adhesive core layer being constructed and arranged to provide the passage of gaseous water but substantially prevent the passage of liquid water.

Claims 26-29 and 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S.

Patent 6,075,179 issued to McCormack et al. (McCormack).¹

Improper speculation and assumptions with regard to claim scope would be required in order to determine whether anticipation was established by the Examiner. Accordingly, we

¹The Patent has an effective filing date of December 20, 1994.

reverse the Examiner's § 102 rejection on procedural grounds and, pursuant to our authority under 37 CFR § 41.50(b),² we enter a new ground of rejection under 35 U.S.C. § 112, ¶ 2. Our reasons follow.

OPINION

One of the major questions in this case is whether McCormack describes outer layers which are "substantially free of particulate filler," a requirement in all of the claims. The Examiner finds that the skin layers 18 and 20 of McCormack are substantially free of particulate filler because the skin layer is not necessarily required to include particulate fillers (Answer, p. 3), but Appellant argues that the skin layers of the McCormack examples incorporate anti-block compounds that contain a filler such as diatomaceous earth and are not substantially filler free outer layers as claimed (Brief, p. 3 citing McCormack, col. 3, ll. 55-63 for filler descriptions). Neither the Examiner nor the Appellant address the key underlying question: At what level of particulate filler do the outer layers become "substantially free of particulate filler?" Before one can determine whether what is in the prior art anticipates what is claimed, one must understand the scope of the claim.

The word "substantially" in the limitation "substantially free of particulate filler" is a term of degree. When a word of degree is used in the claim, the specification must provide some

²37 CFR § 41.50(b) replaced 37 CFR § 1.196(b) on September 13, 2004.

standard for measuring that degree. *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). Absolute precision is not required, what is required is enough guidance to allow those of ordinary skill in the art to understand what is encompassed by the claim. *Id.* If the level of guidance in the specification does not provide the required standard for measuring that degree, the claim is indefinite under 35 U.S.C. § 112, ¶ 2.

Looking to the specification, we do not find the required standard for measuring the degree to which fillers are allowed to be present in the outer layer. The phrase “substantially free of particulate filler” is present on pages 7 and 8 of the specification. But we find no discussion of what level of filler is “substantial.” Nor do we find a level of guidance which would allow one to determine what is a “substantial” amount of filler. Moreover, there are examples disclosed in the specification in which layer C is disclosed as containing 60% Ampacet 100720 (Examples 6 and 7). According to the specification at page 13, lines 11-19, Ampacet 100720 is a particulate filler concentrate containing calcium carbonate filler. The specification indicates that filler concentrates such as Ampacet 100720, at a minimum, contain 50% filler (specification, p. 13, ll. 11-19). Therefore, the skin layer of Examples 6 and 7 contain, at a minimum, 30% filler (Examples 6 and 7). Whether the recitation “substantially free of particulate filler” as recited in the claims encompasses the filler amounts of Example 6 and 7 is unknown: The specification is silent in this regard.

The amounts of filler excluded by “substantially free of particulate filler” is not determinable on this record. We, therefore, conclude that claims 26-29 and 32 are indefinite and thus fail to meet the requirements of 35 U.S.C. § 112, ¶ 2.

There is another problem with the claims. Appellant argues that the claims require that the core layer be stretched to create about 27.6% to about 42% microvoids (Brief, p.3), but there is no affirmative limitation in the claims to that effect. Rather, both independent claims precede the limitation with the words “where upon.” The words “where upon” indicate that the action of stretching is a future action which may be done but is not required to be done. On the other hand, the claims are directed to a breathable film and it is not clear that the film is breathable before stretching as the micropores are created in the core layer only upon stretching. It appears that the claims are not limited as intended by Appellant. The claims are thus indefinite for this reason as well. *See In re Collier*, 397 F.2d 1003, 1005, 158 USPQ 266, 267-68 (CCPA 1968).

For the above reasons, we conclude that the claims do not satisfy the requirements of 35 U.S.C. § 112, ¶ 2 and, therefore, we newly reject claims 26-29 and 32 under 35 U.S.C. § 112, ¶ 2 pursuant to our authority under 37 CFR § 41.50(b).

Because the scope of the claims is unclear, we are unable to resolve the issues on appeal with respect to the rejection of claims 26-29 and 32 as anticipated by McCormack. To resolve those issues, we would have to resort to speculation as to the meaning of the terms of the claims. It would be inappropriate for us to resort to such speculation. *In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962)(A rejection should not be based on speculations as to the

meaning of the terms employed and assumptions as to the scope of the claims). We, therefore, procedurally reverse the rejection over McCormack. We emphasize that our reversal of the 35 U.S.C. § 102 rejection is not a reversal on the merits of the rejection, but rather a procedural reversal predicated upon the indefiniteness of the claimed subject matter.

The above being said, we add the following comments to facilitate any further prosecution on the issues of the 35 U.S.C. § 102 rejection.

First, we note that the Examiner discusses a reference, Antoon, Jr. in the body of the rejection, but does not list this reference in the statement of the rejection.³ At the very least, discussing a reference in the body of the rejection without affirmatively listing it in the statement of rejection leads to confusion as to the true grounds of the rejection. Such a circumstance also greatly increases the chance that an applicant will overlook the unlisted reference and misunderstand the true evidentiary basis for the rejection. For these reasons, every reference discussed in the rejection must be listed in the statement of the rejection to give the applicant appropriate notice of the evidence relied upon in the rejection. *See In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970)(Where a reference is relied on to support a rejection, whether or not in a "minor capacity," there would appear to be no excuse for not positively including the reference in the statement of rejection.).

³Antoon, Jr. was discussed in the First Office Action (Paper No. 19, ¶¶ 3-4) as well as in the Answer. The discussion from the First Office Action was incorporated by reference into the Final Rejection. At no time did the Examiner list Antoon, Jr. in the statement of the rejection.

We are cognizant of the fact that the rejection is a § 102 rejection. The use of supporting evidence is permissible in an anticipation rejection in some circumstances. One such circumstance is when the anticipatory reference is silent about a characteristic, but another reference provides evidence that the characteristic is inherently present in the thing taught by the anticipatory reference. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (“To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence.”). But, in every case, the additional reference must be mentioned in the statement of the rejection to give the applicant appropriate notice of the examiner’s reliance upon it.

In response to Appellant’s argument that McCormack teaches anti-block compounds containing a filler such as diatomaceous earth, we note that only Examples 1 and 2 contain such a disclosure. Examples 3-5 describe the inclusion of 20 percent Techmer S110128E62 antiblock, but there is no evidence of record indicating that this antiblock contains filler.

Turning, for illustration purposes only, to Example 3 of McCormack, we note that described therein is a three layer breathable film with a core layer sandwiched between two skin layers such that the film has the C:D:C structure of the claims. The core layer contains 63% ECC English China Supercoat™ calcium carbonate in a blend of polyolefins. According to Example 1, this filler has an average particle size of 1 micron, a size within the requirements of the claims. The skin layers contain EVA, i.e, ethyl vinyl alcohol polymer, a polymer which Appellant exemplifies in their specification as being a hydrophilic polymer resin capable of

absorbing and desorbing moisture (specification, p. 14, ll. 25-29). The three layer film is extruded and later stretched 4x, i.e., to 4 times its length, thus indicating that the core layer is microporous. The film had a water vapor transmission rate of 1301 g/m²/24hr, thus indicating that the film is breathable. A laminate including the film had a hydrohead of 110 cm, thus providing evidence that the film provides a barrier to liquids, blood and bodily fluids, and microorganisms. The laminate had a peel strength of 161 grams indicating that the film layers were adhesive to each other.

While Appellant claims the multilayer film in terms of functions and properties not directly expressed in McCormack's examples, that does not foreclose a finding of anticipation. If the claimed functions and properties are inherently possessed by any of the films exemplified by McCormack, the claims are anticipated. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433-34 (CCPA 1977). We note that the PTO has no mechanism in which to manufacture and test the films of McCormack to verify that the films are the same or substantially the same. Therefore, it is eminently fair and acceptable to shift the burden to Appellant and require them to prove that the subject matter shown to be in the prior art does not, in fact, possess the properties they are relying upon for patentability. *Id.* This is particularly true, where, as here, it appears that the reference and the claims are describing films developed within the same corporation, i.e., Kimberly-Clark Worldwide. Appellant is in a better position to obtain the prior art products and make the required comparisons than is the PTO. *Id.*

Upon further prosecution, the Examiner should review the examples of McCormack and determine whether there is a reasonable basis to believe that the films of any of the examples meet the requirements of any of the claims and revise the rejection as appropriate. *See Best*, 562 F.2d at 1254, 195 USPQ at 433-34 (Before the burden can be shifted to the applicant, the examiner must provide a reasonable basis for a conclusion of inherency). In regard to Examples 1 and 2, the Examiner should note that while those examples describe skin layers containing diatomaceous earth, a material described as a filler in col. 3, ll. 55-63 of McCormack, the amount of diatomaceous earth is small, i.e., on the order of 4% for Example 1 and 3% for Example 2.⁴ The Examiner should consider whether the films of Examples 1 and 2 have skin layers “substantially free of particulate filler.”

The Examiner may wish to consider adding a rejection under 35 U.S.C. § 103(a). The broad disclosure of McCormack provides guidance as to how to select various polymers, fillers, and processing parameters to obtain a three layer breathable film.

⁴The skin layer composition of Example 1 includes 20% Ampacet 10115 anti-block of which 20% is diatomaceous earth. Therefore, the overall skin layer composition contains 4% diatomaceous earth. The skin layer composition of Example 2 includes 15% Ampacet 10115 and, therefore, the overall skin layer composition contains 3% diatomaceous earth.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 26-29 and 32 under 35 U.S.C. § 102(e) is reversed on procedural grounds and a new rejection under 35 U.S.C. § 112, ¶ 2 entered.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

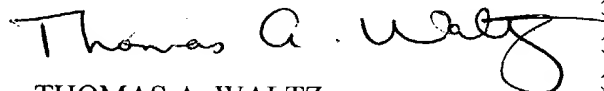
(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; § 41.50(b)


BRADLEY R. GARRISS
Administrative Patent Judge


THOMAS A. WALTZ
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge

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